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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,286	10/16/2001	John Fruehauf	97,150-C	8043

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EXAMINER

HUMPHREY, DAVID HAROLD

ART UNIT PAPER NUMBER

1643

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,286

Applicant(s)

FRUEHAUF, JOHN

Examiner

David Humphrey

Art Unit

1643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendments and Arguments

1. Claims 1-9 and 11-20 are pending.

Claim 1 has been amended.

Claim 10 has been cancelled.

Claims 11-20 are withdrawn as being to a non-elected invention.

Claims 1-9 are examined on the merits.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Withdrawn Rejections

Claim Rejections - 35 USC § 112

3. The rejection of claims 1-7 and 10 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of making a prognosis of disease course in a breast cancer or prostate cancer patient, does not reasonably provide enablement for a method for making a prognosis of disease in melanoma or any other cancer patient other than breast or prostate, is withdrawn due to Applicant's amendments to the claims.

Maintained Rejections

Double Patenting

4. The rejection of claims 1-9 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7, 9 and 10 of U.S. Patent No. 6,303,324 (cited in Applicant's IDS), is maintained.

Applicant argues that since the instant application is a divisional application claiming priority to U.S. Application 09/199,217 filed on November 24, 1998 (now U.S. Patent 6,303,324), the Patent Office has thus previously determined that the invention claimed in the instant application is patentably distinct from the invention claimed in U.S. Patent 6,303,324, see Remarks, page 6, lines 16-20.

Applicant's arguments have been carefully considered, but found not persuasive. The prosecution history of U.S. Application 09/199,217 does not include an election/restriction requirement. The original claims of 09/199,217 (claims 1-13) were examined in the Office Action mailed on 12/27/99 without a restriction requirement. Applicants responded on 04/27/00. And the claims were later allowed without a restriction requirement. Parent case, U.S. Application 08/843,008, was a 1st action allowance, 04/01/98, and did not contain a restriction requirement. While Applicant claims that the instant application is a divisional of 09/199,217 which is a divisional of 08/843,008, it is not clear how these applications could in fact be divisionals of each other if there is no restriction requirement. Applicant must clarify this issue.

Therefore, contrary to Applicant's arguments, the Office has not established that the claimed invention in the instant application is patentably distinct from the invention claimed in U.S. Patent 6,303,324. Thus, the rejection of claims 1-9 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7, 9 and 10 of U.S. Patent No. 6,303,324 (cited in Applicant's IDS), is maintained for the reasons of record, see Office Action mailed on 11/22/05, pages 7-9.

Conclusion

5. No claim is allowed.

6. No new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1643

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Humphrey whose telephone number is (571) 272-5544. The examiner can normally be reached on Mon-Fri 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Humphrey, Ph.D.

May 19, 2006



LARRY R. HELMS, PH.D.
SUPERVISORY PATENT EXAMINER